

REMARKS

This paper is presented in response to the non-final official action dated November 28, 2007, wherein: (a) claims 1 and 3-25 are pending; (b) claims 14-25 have been withdrawn from further consideration in view of the restriction requirement imposed in the official action dated July 13, 2006, made final in the action dated August 24, 2006; (c) claims 1, 3-5, 8, and 10-13 have been rejected under 35 USC § 103(a) as being obvious over Slavtcheff et al. U.S. Patent No. 6,451,331 in view of Bries et al. U.S. Patent No. 5,110,843; and, (d) claims 6, 7, and 9 have been rejected under § 103(a) as being obvious over the Slavtcheff patent. Reconsideration and withdrawal of the rejections are respectfully requested in view of the foregoing amendments and following remarks.

This paper is timely filed as it is accompanied by a petition under 37 CFR § 1.136(a) for an extension of time to file in the first month, and payment of the required extension fee.

I. Summary of the Recent Prosecution of this Application

On February 8, 2007, the Patent Office mailed a final action rejecting the pending claims as being obvious on the same basis and over the same art applied in the current action. On April 4, 2007, the applicants filed a notice of appeal and an appeal brief. On June 18, 2007, the Patent Office mailed a notification that the April 4 brief was non-compliant. On July 16, 2007, the applicants re-filed their appeal brief attempting to correct non-compliant aspects of their April 4 brief. On October 11, 2007, the Patent Office mailed a notification that the July 16 brief was non-compliant. On October 31, 2007, the applicants re-filed their appeal brief attempting to correct non-compliant aspects of their July 16 brief. Also on October 31, 2007, the applicants filed a request for continued examination (RCE) pursuant to 37 CFR § 1.114, and submitted a supplemental information disclosure statement (IDS).

In requesting continued examination, the Patent Office was required to withdraw the finality of the February 8, 2007, action and consider the applicants submission (i.e., the supplemental IDS). The Patent Office, however, was *not* required to consider the merits of the applicants' October 31 appeal brief because the RCE effectively withdrew the appeal and reopened prosecution. See 37 CFR § 1.114(d) ("If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§ 41.37 of this title) or a reply brief (§ 41.41 of this title), or related papers, will not be considered a submission under this section.").

In view of the foregoing, the applicants understand that the Patent Office did not consider the merits of the applicants' October 31 appeal brief and, accordingly, simply re-

stated (verbatim) the § 103(a) rejections described in the February 8, 2007, final action. This paper, therefore, re-presents the applicants appeal brief arguments traversing the § 103(a) rejections, respectfully requests consideration of those arguments, and respectfully requests reconsideration and withdrawal of all of the § 103(a) rejections.

II. The 35 USC § 103(a) Rejections

Claims 1, 3-5, 8, and 10-13 have been rejected under 35 USC § 103(a) as being obvious over Slavtcheff et al. U.S. Patent No. 6,451,331 in view of Bries et al. U.S. Patent No. 5,110,843. See the Action at 2-5. Claims 6, 7, and 9 have been rejected under § 103(a) as being obvious over the Slavtcheff patent. See *id.* at 4. The applicants respectfully submit that the subject matter recited in the pending claims is not obvious over the combined disclosures of the applied prior art. Accordingly, the applicants respectfully traverse the rejections for the reasons expressed below, and respectfully request reconsideration and withdrawal of the rejections.

A. Proper Basis for a § 103(a) Rejection

The action properly describes 35 USC § 103(a). A determination that a claimed invention is obvious under § 103(a) is a legal conclusion involving four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the claimed subject matter pertains, who is presumed to have all prior art references in the field of the invention available to him/her. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Furthermore, obviousness must be determined as of the time the invention was made and in view of the state of the art that existed at that time. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-51 (Fed. Cir. 1988).

The Patent Office “has the burden under § 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); MPEP § 2142 (8th Ed., Rev. 6, Sept. 2007) (“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.”). The Supreme Court recently identified a number of rationales that may be used to support a conclusion of obviousness, consistent with the framework set forth in its decision in *Graham v. John Deere Co.* See *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739-40 (2007). These and other representative rationales are described at MPEP § 2143 (8th Ed., Rev. 6, Sept. 2007). Regardless of the supporting rationale, however, the Patent Office must clearly articulate facts and reasons why the claimed invention “as a whole” would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention’s effective filing date. See *KSR Int'l*, 127 S.Ct. at 1741

(citing with approval *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”); see also MPEP § 2143 (“The key to supporting any rejection under 35 USC § 103 is the clear articulation of reason(s) why the claimed invention would have been obvious.”).

B. The § 103(a) Rejections Are Traversed

The action does not clearly articulate facts and reasons why the claimed invention “as a whole” would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention’s effective filing date. Specifically, the action does not articulate accurate findings of fact relating to the scope and content of the applied prior art, and the differences between the claimed invention and that applied prior art. Still further, while the action appears to rationalize its conclusion of obviousness, the action does not articulate facts sufficient to support the asserted rationale. See MPEP § 2143. The action, therefore, does not set forth a *prima facie* case of obviousness. Accordingly, the applicants respectfully traverse the rejections, and request reconsideration and withdrawal of the rejections.

The claimed subject matter relates to an article for cleansing body surfaces. The article includes an effervescent composition that includes solid alkaline and acidic materials, and a liquid-permeable laminate. The liquid-permeable laminate includes a plurality of layers. More specifically, the liquid-permeable laminate has a first layer that includes a web, and a second layer (in contact with the first layer) that includes a plurality of webs. The effervescent composition is present between the webs that make up the second layer. A lathering surfactant is distributed over the web surface of the first layer that is opposite the surface (of the first layer) in contact with the second layer. The laminate and its layers are illustrated in the drawing (“Fig. 3”) below:

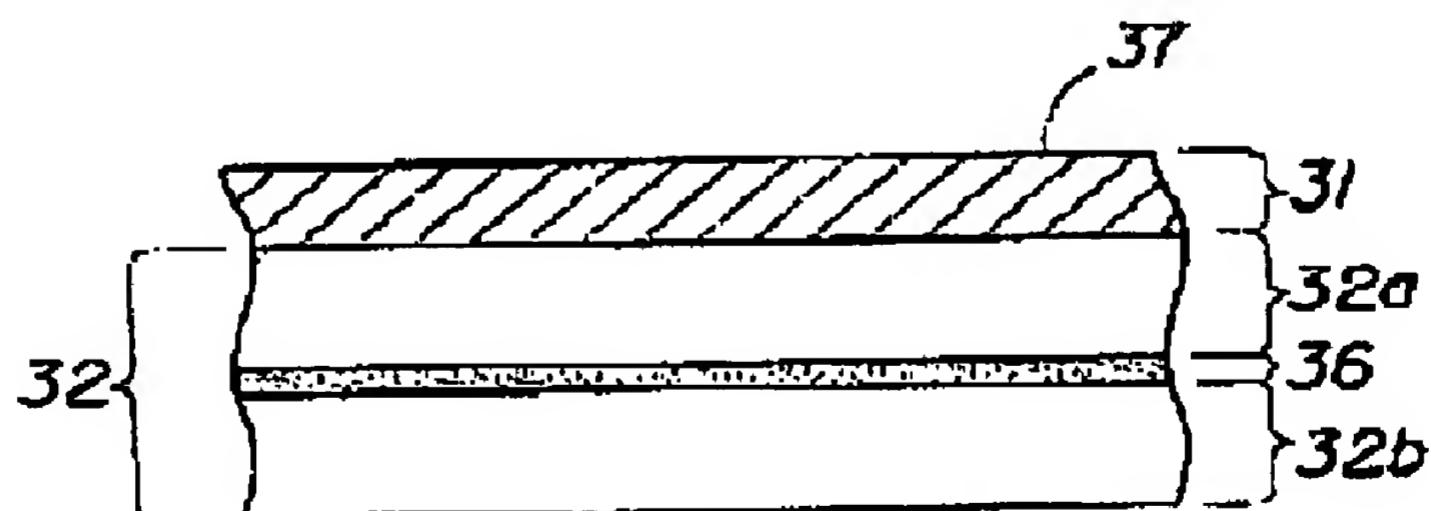


Fig. 3

As shown in Fig. 3, the first layer **31** is in communication over its entire surface with the top surface of a second layer **32**. In Fig. 3, the surfactants **37** are primarily located on the first layer **31**, specifically on the surface of the first layer web opposite the contacting surfaces of the first and second layers **31** and **32**, respectively, of the laminate. In Fig. 3, the second layer **32** includes two webs **32a** and **32b**, wherein the effervescent composition **36** is placed between the two webs **32a** and **32b**.

By placing the effervescent composition between the webs of the second layer, the effervescent composition desirably does not agglomerate and/or cake; the effervescent composition therefore remains evenly spread over the web surface and throughout the laminate, and facilitates consistent and steady activity of the article when wetted. Accordingly, it was (and is) an object of the claimed invention to eliminate the dry flowing powders from gas-generating chemistry that inhibits optimum foaming and lathering. To achieve this, the surfactant is placed in a position *other than* with the gas-generating chemistry so that the aggregating or caking of the gas-generating chemistry does not inhibit the generation of gas and transfer of water to surfactants so that there is optimum foaming. Thus, the lathering surfactant and the effervescent composition are in *separate locations* within the cleansing article.

The action supports the § 103(a) rejection of independent claim 1 (and claims 3-5, 8, and 10-13 dependent therefrom) by the rationale that a person having ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention *and* that there would have been a reasonable expectation of success. See the Action at 4.

The combination of the Slavtcheff and Bries patents does not teach or suggest all of the features recited in rejected independent claim 1 (or any claim depending from claim 1) and, therefore, this combination cannot support a *prima facie* case of obviousness. Specifically, this combination does not teach or suggest a cleansing article that includes an effervescent composition and a lathering surfactant *separately located* within the cleansing article. The Slavtcheff patent teaches “a swiping article which includes an effervescent cleanser composition held within a sachet.” See the Slavtcheff, abstract. The surfactant and the effervescent composition in the article of the Slavtcheff patent are *positioned together* within the sachet. See *id.* at col. 4, lines 15-17 and 65-67, Examples 1-6, and claims 1 and 5. The Bries patent teaches articles containing multilayers of polyurethane foam having a detergent or cleaner impregnated in an inner layer. See the Bries patent at col. 5, lines 49-52. The Bries patent *does not teach* another composition, such as an effervescent composition, in addition to the detergent or cleaner *in a separate location* within the article.

The action does not articulate any findings that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to

one of ordinary skill in the art, to modify the Slavtcheff patent or to combine its teachings with those in the Bries patent. Specifically, the action does not set forth any findings of a suggestion in the Slavtcheff or Bries patents to modify the cleansing article of the Slavtcheff patent to have two compositions disposed in separate areas/parts of the cleansing article. The asserted rationale supporting the § 103 rejection does not apply, however, absent such findings. See MPEP § 2143 (G). The applicants respectfully submit that a person having ordinary skill in the art having no knowledge of the applicants' disclosure and having read the the Slavtcheff and Bries patent would *not* be motivated to make a cleansing article that includes an effervescent composition and a lathering surfactant, disposed in separate locations within the article. The applicants further submit that the Bries patent would not motivate the skilled artisan to separate the surfactant and effervescent composition of the Slavtcheff patent, at least because the Bries patent does not even teach an article that includes two compositions in separate locations within an article. The applicants respectfully submit that the motivation to modify the Slavtcheff patent's disclosure can be found only in the applicants' disclosure. The mere fact that the applied prior art can somehow be combined or modified does not render the resultant combination obvious unless the results would have been predictable to the ordinarily skilled artisan. See *KSR Int'l*, 127 S.Ct. at 1740. The action presents no such findings.

Each of dependent claims 6, 7, and 9 appear to have been rejected under § 103(a) as being obvious over the Slavtcheff patent *alone*, whereas the independent claim (i.e., claim 1) from which each of claims 6, 7, and 9 depends was rejected under § 103(a) over a *combination* of the Slavtcheff and Bries patents. Because, as the applicants have argued above, that the combination does not render independent claim 1 obvious, the applicants respectfully submit that the Slavtcheff patent *alone* cannot possibly render dependent claims 6, 7, and 9 obvious.

C. Conclusion

In view of the foregoing, the applicants respectfully traverse the § 103(a) rejections and submit that the claimed invention is unobvious. The applicants, therefore, request reconsideration and withdrawal of the rejection.

Prima facie obviousness under § 103 is a legal conclusion—not a fact—based on underlying facts. *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976); *In re Kumar*, 418 F.3d 1361, 1365 (Fed. Cir. 2005) (“Determination of obviousness under 35 USC § 103 is a legal conclusion based on underlying facts.”). The foregoing response identifies facts (e.g., evidence in the form of statements in the prior art) rebutting the alleged legal conclusion that the claimed invention is prima facie obvious. All of these facts must be evaluated along with the facts on which the legal conclusion was originally reached—not the legal conclusion itself.

Having requested herein reconsideration of the legal conclusion set forth in the official action, the Patent Office is obligated to address all of the evidence and base its forthcoming legal conclusion(s) on such evidence, uninfluenced by its earlier conclusions. *Rinehart*, 531 F.2d at 1052.

CONCLUSION

In view of the foregoing, the applicants respectfully reconsideration and withdrawal of all of the outstanding rejections, and allowance of all of the pending claims.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned attorney.

Respectfully submitted,

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